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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,941	01/30/2004	Dietmar Janz	P24819	4403
7055	7590	07/12/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LAMB, BRENDA A	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,941

Applicant(s)

JANZ ET AL.

Examiner

Brenda A. Lamb

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,12-25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12,13,16,17,20-25 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/3/2006 has been entered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7,9,10,12-13 and 29-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed specification fails to teach or suggest that a free end of the tip of tube is positioned approximately generally level with the free end of the tip of the applicator nozzle.

Figure 1 of the originally filed specification shows the tip or end surface of the tube is at an angle relative to the flat vertical end surface of the free end of the tip of the applicator nozzle.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 28 of the method step of conveying, after the feeding, the moving web is confusing since independent claim 16 recites the system controls or regulates the amount of the substance applied to the moving web or a web which is being conveyed. It is unclear how the recitation that the system is arranged on one of a continuous cigarette making machine and a cigarette packing machine in claim 3 further limits claim 1 which is directed to a system for applying glue.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 10, 12 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Venema 6,297,300.

Venema teaches the design of a system for applying glue to a moving web, the system comprising the following elements: a nozzle coupled to the coating reservoir; the nozzle comprising a tip 28 having an outlet opening arranged to apply a coating to the substrate; a device or feeding device that delivers a gaseous substance to a region of the outlet opening; and the device is comprised a tube whose tip 32 is angled to correspond to a tapered portion of the tip of the nozzle, whereby the tip of the tube is arranged adjacent the tip of the nozzle and the device is separate from the nozzle and delivers the substance behind the outlet opening. Venema system is capable of applying coating to a moving web which moves along a given direction and capable of being positioned such that the device delivers the substance behind the outlet opening relative to the direction of travel of the web. However, absent the new matter, Venema teaches every element of the claimed system as set forth in claim 1. With respect to claims 4, 12 and 29, the same rejection applied to claim 1 is applied here. Venema teaches a system which includes pipe 24 for feeding the substance to the device or feeding device. Venema system for feeding the substance is capable of feeding a substance within the scope of the claim since it teaches every positively claimed

element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claims 2-3, absent a clear recitation of a continuous cigarette making machine and a cigarette packing machine which includes a glue applying system as set forth in claim 1, Venema system is capable of coating a substrate within the scope of the claims or is capable of being arranged on a machine within the scope of the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 10, the tip of the device abuts the nozzle. With respect to claim 5, Figure 2 of Venema shows the device delivers the substance behind the outlet opening.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Venema 6,297,300.

Venema is applied for the reasons noted above but fails to teach the tube is a capillary or a tube of very small diameter. However, it would have been obvious matter

of design choice to use as the tube in the Venema system/apparatus one that is a capillary tube or tube having a very small diameter since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claims 6, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venema 6,297,300 in view of Kenderi et al.

Venema is applied for the reasons noted above but fails to teach the system for feeding the substance includes an amount of the substance which is applied to the moving web. However, it would have been obvious to modify the Venema apparatus by providing a control valve to control/regulate the flow of the substance within the coating applying system since Kenderi et al teaches using a control valve to control/regulate the flow of the substance within the coating applying system for the obvious reason of greater control of the process. The Venema system/apparatus as modified is capable of regulating the amount of the substance applied to the moving web since it teaches every element of the claimed system/apparatus as set forth in claim 9. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 6, it would have been obvious given the

modifications of the Venema apparatus as discussed above with the Kenderi et al valve to control the flow of the substance as discussed above is capable of delivering the substance in the form of spots via manipulation of the control valve. With respect to claim 9, it would have been obvious to arrange the device in the Venema system such that it is spaced a distance from the nozzle, which broadly reads on any distance greater than zero, since Kenderi et al shows spacing the device from the nozzle for applying coating for the obvious reason to facilitate maintenance.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Venema 6,297,300 in view of Kenderi et al and Warning, Sr. et al.

Venema is applied for the reasons noted above but fails to teach his nozzle applies glue and regulating an amount of the substance which is applied to the moving web. However, it would have been obvious to modify the Venema process and apparatus to apply glue from its nozzle since Warning, Sr. et al teaches applying glue by atomizing the glue. Further, it would have been obvious given the modifications of the Venema apparatus as discussed above to provide a valve such as taught by Kenderi et al to control the flow of the substance as discussed above which applied along with the coating to the web for the obvious advantage of greater control of the process.

Claims 16-17, 20, 23 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by McIntyre 4,476,165.

McIntyre '165 method of applying glue to a moving web utilizing a system that includes a glue nozzle coupled to a glue reservoir, the glue nozzle comprising a tip

having an outlet opening arranged to apply glue to the moving web, and a device that delivers a substance to a region of the outlet opening, wherein the device is a tube 18 whose tip assembly or head as shown on Figure 3 is arranged adjacent the tip of the glue nozzle, the method comprising: applying the glue onto the moving web while the moving web direction, feeding the substance behind the outlet opening relative to the direction; and at least one of controlling an amount of the substance which is applied to the moving web which includes valve 6'. Thus every claimed method step of the method as set forth in claim 16 is taught by McIntyre. With respect to claim 17, the recitation that the substance comprises a low viscosity fluid does not define applicant's invention over McIntyre '165 since McIntyre '165 teaches his apparatus is capable of applying substance having a wide variety of viscosities and therefore it is capable of applying coating including those which have a low-viscosity compared to that dispensed from the glue nozzle. With respect to claims 20 and 23, McIntyre '165 method includes the method step of continuously feeding the substance behind the outlet opening relative to the direction by controlling the feeding of the substance to the device via an extruder valve (see column 4 lines 1-10). With respect to claim 28, McIntyre '165 shows conveying the web away from the device.

Claims 16, 21-24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by McIntyre 4,725,468.

McIntyre '468 method of applying glue to a moving web utilizing a system that includes a glue nozzle coupled to a glue reservoir, the glue nozzle comprising a tip having an outlet opening arranged to apply glue to the moving web, and a device that

delivers a substance to a region of the outlet opening, wherein the device is a tube as shown in Figure 2 whose tip assembly or head is arranged adjacent the tip of the glue nozzle, the method comprising: applying the glue onto the moving web while the moving web direction, feeding the substance behind the outlet opening relative to the direction; and at least one of controlling an amount of the substance which is applied to the moving web which includes metering pump 14'. Thus every claimed method step of the method as set forth in claim 16 is taught by McIntyre '468. With respect to claims 21-22, McIntyre '468 shows in Figure 3 the upper layer substance is applied intermittently and cyclically on top of the lower layer dependent on the speed of travel of the moving web. With respect to claim 28, McIntyre '468 shows conveying the web away from the device. With respect to claims 23-24, McIntyre '468 teaches controlling the feeding on a timely basis (see column 2 lines 25-44).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre 4,725,468 in view McIntyre 3,595,204.

McIntyre '468 is applied for the reasons noted. McIntyre '468 fails to teach controlling the feeding on a quantity basis. However, it would have been obvious to control the quantity of the dispensed from the positive displacement metering pump in the McIntyre '468 process since McIntyre '204 teaches metering pumps enable one to dispense various quantity of the coating dependent on the rate of travel of the substrate.

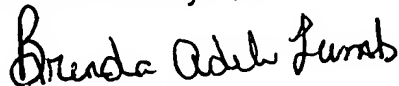
Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejections.

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Claims 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-15 are allowed.

Any inquiry concerning this communication should be directed to Brenda A. Lamb at telephone number (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday with alternate Wednesdays off.


Brenda A Lamb
Examiner
Art Unit 1734